



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,194	12/15/2000	Emmanuel Vyers	NCP3-E42	1141

7590 12/24/2003

Karl M. Steins
Steins & Associates
Suite 120
2333 Camino del Rio South
San Diego, CA 92108

EXAMINER

KRISHNAMURTHY, RAMESH

ART UNIT	PAPER NUMBER
----------	--------------

3753

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/738,194

Applicant(s)

VYERS ET AL.

Examiner

Ramesh Krishnamurthy

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 - 12, 14 - 17 and 19 - 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 - 12, 14 - 17, 19, 20 and 22 - 32 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

This office action is responsive to amendment filed on 10/21/2003.

Claims 9 – 12, 14 – 17 and 19 – 32 are pending.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 9 – 12, 14 – 17, 19, 20 and 22 – 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art cited by the applicant on pages 2 – 8 of the specification and in Figs. 1 – 3 in view of WO 97/16777.

The prior art cited by the applicant on pages 2 – 8 of the specification and in Figs. 1 – 3 anticipates the method recited in claims 9 – 12, 14 – 17, 19, 20 and 22 – 32 with the exception of having a valve position feedback signal that comprises data representing the position of a motor drive operationally connected to the valve.

WO 97/16777 discloses a pressure control apparatus (See Abstract and Fig. 1) in which a position sensor (22) is used to provide a feedback signal comprising data representing position of a motor drive (comprising coupling between the motor (40) and the rotary valve (14)) actuating the valve for the purpose of providing an indication of the position of the valve thereby improving the accuracy of the valve control.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated a position sensor in the prior-art arrangement disclosed by the applicant for the purpose of providing an indication of the position of the valve thereby improving the accuracy of the valve control. In the prior-art arrangement disclosed by the applicant only an indirect inference of the valve position was possible via the measured pressure each time the valve was moved to a new position. Having a position sensor connected to the motor drive actuating the valve would provide a direct indication of the valve position thereby improving the overall efficacy of pressure/flow control.

Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

5. Applicant's arguments filed 10/21/2003 have been fully considered but they are not persuasive.

It is noted that by absence of any specific comments, applicant has not disputed examiner's finding that the prior art cited by the applicant on pages 2 – 8 of the specification and in Figs. 1 – 3 anticipates the method recited in claims 9 – 12, 14 – 17, 19, 20 and 22 – 32 with the exception of having a valve position feedback signal that comprises data representing the position of a motor drive operationally connected to the valve.

Applicant is essentially arguing that the method corresponding to WO 97/16777 is patentably distinct from that claimed in the instant application. However it should be noted that the rejection of claims in the instant application is based on a combination of the WO 97/16777 reference (the Eckhardt reference) with the prior art cited by the applicant on pages 2 – 8 of the specification and in Figs. 1 – 3. The reliance on the Eckhardt reference is for the teaching it provides in regard to the use of a feedback signal comprising data representing the position of the motor drive actuating the valve. Applicant's response does not appear to address this essential aspect of the rejection

involving **combination** of the Eckhardt reference with the admitted prior art, as set forth above, as well as in paper no. 14. In response to applicant's arguments against the reference(s) individually, it is noted that one cannot show nonobviousness by attacking reference(s) individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to Applicant's arguments that the Eckhardt reference is teaching away from the Applicant's claimed invention, it is noted that while Eckhardt reference discloses a comparison of the measured position of the motor drive and its corresponding ideal value, it nevertheless still teaches the use of the measured position of the motor drive as part of the feedback signal that actuates the valve in controlling the pressure of a chamber. While the applicant's invention as claimed may not recite a comparison of the measured position of the motor drive with its corresponding ideal value, the fact that the Eckhardt reference teaches such a comparison would not suggest to one of ordinary skill in the art that it is teaching away from the Applicant's invention that relies on the measured position of the motor drive being a part of the feedback signal that actuates the valve in controlling the pressure of a chamber.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramesh Krishnamurthy whose telephone number is (703) 305 - 5295. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Scherbel, can be reached on (703) 308 - 1272. The fax phone number for the organization where this application or proceeding is assigned is (703) 872 - 9306.

Application/Control Number: 09/738,194

Page 6

Art Unit: 3753

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 - 0861.

A handwritten signature in black ink, reading "Ramesh Krishnamurthy". The signature is written in a cursive style with a large, stylized 'R' and a long, sweeping tail.

Ramesh Krishnamurthy

Examiner

Art Unit 3753

December 23, 2003